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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,063	07/28/2003	Alexey S. Kabalnov	200309257-1	5846

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,063

Applicant(s)

KABALNOV ET AL.

Examiner

Julian D. Huffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10-24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 8, 12, 14-16, 18, 20, 23 and 26-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 December 2005 has been entered.

Election/Restrictions

2. Claims 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2 May 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 27, 28, 30 and 31 are rejected under 35 U.S.C. 102(e) and 35 U.S.C. 102(a) as being anticipated by Lee (U.S. 20030025321 A1).

Lee discloses:

With regards to claims 27 and 28, a print medium (fig. 2) having a magnetic strip (8) as a data storage device attached thereto, said print medium being configured to receive a printed image (print medium has an ink receptive layer 10 to receive a printed image), and said data storage device being configured to receive and store printing information comprising data related to content of the printed image (0020, 0021).

With regards to claims 30 and 31, a method for associating printing information with a print medium, comprising the steps of:

attaching a magnetic strip (8) as a data storage device to a print medium; and
storing printing information on the data storage device, said printing information comprising data related to content of a printed image applied to the print medium (0020, 0021).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23, 26, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Smith (EP 0884195 A1).

Lee discloses:

With regards to claims 1, 4 and 7, a print medium (fig. 2) having a rewritable data storage device (fig. 2, element 8) attached thereto (section 0019), said print medium being configured to receive a printed image (layer 10 receives a printed image 14), and said data storage device configured to receive and store printing information comprising data related to the print medium (0020, 0021) wherein the printed image has been applied to the print medium (0022) and the data storage device comprises a rewritable magnetic strip (8) and stores data related to the printed image (0021, 0022).

With regards to claims 8 and 16, an ink jet printing system (0011, 0017) comprising:

- a print medium configured to receive a printed image (fig. 2, layer 10 receives printed image 14);

- a rewritable data storage device (8) attached to the print medium (0019), said data storage device configured to receive and store printing information (0020, 0021);

- a printer configured to print the image on the print medium (0011, 0017) and
- a printing information processor associated with the printer, said printing information processor comprising a data read processor capable of reading data from the data storage device (0023).

With regards to claims 12 and 15, the data storage device comprises a rewritable magnetic strip (8) which stores information relating to the printed image which has been applied to the print medium (0020, 0021).

With regards to claims 20, 23 and 26, a method of associating printing information with a print medium, comprising the steps of:

attaching a rewritable data storage device comprising a rewritable magnetic strip (8) to a print medium (0019); and

storing printing information on the data storage device, said printing information comprising data relating to the print medium and including information relating to printed material applied to the print medium, on the data storage device (0020, 0021).

Lee discloses everything claimed with the exception of a printing information processor integrated with the printer capable of reading and writing data and providing information indicative of properties of a print medium.

Smith discloses a printing information processor (fig. 1, element 20) integrated with a printer (10) which controls the printer to print and read a code on the print media (fig. 1, controller is connected to optical sensor 34 which reads the data and printhead 12 which prints the data on the paper, column 3, lines 47-50, column 4, lines 19-22), wherein the code includes data which indicates the type of print medium used in the printer (column 3, lines 35-38).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the printer of Lee with an integrated information processor to read and write the information, and to store the media type in the code, as suggested by Smith, for the purpose of providing a means for the printer to read and write the coded information thereby enabling functionality of the system without requiring external control or processing means and providing information about media type to the printer controller to automatically optimize print quality for the designated media type (column 2, lines 20-23).

Response to Arguments

7. Applicant's arguments filed 12 December 2005 have been fully considered but they are not persuasive.

Applicant's argument regarding claims 27 and 30, that Lee discloses storing a magnetically encoded copy of the text and images printed on the ink receptive layer and not data related to content of the printed image, is noted. However, the language "data related to content of the printed image" does not preclude the storage of the printed image. Applicant's own specification on page 7, lines 22-24 recites that "information related to the image on the print medium can also comprise data files, including the original image data file". Furthermore, Lee also teaches that the magnetic storage device may store a watermark or printed information to verify that a document is authentic (0020) and that the magnetic storage layer and ink receptive layer may each contain different or identical information (0021), any of which constitute information related to the printed image.

Arguing the 103 rejection, applicant presents arguments solely directed towards the secondary reference, Smith, and argues that Smith is clearly not relevant to the present claims, as Smith makes no reference to a rewritable storage device and provides no teach that would enable use of a rewritable storage device. However, Lee alone teaches a rewritable storage device since magnetic storage devices are rewritable. Smith is not relied on for teachings of a re-writable storage device.

Arguing the 103 rejection, applicant also presents arguments solely directed towards Lee and argues that Lee does not disclose providing a printing information processor capable of both reading and writing data to the data storage device. The

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examiner has admitted to such in the rejection, and this deficiency is cured by Smith in the combination.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 10:00a.m.-6:30p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julian D. Huffman
26 January 2006